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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,206	10/27/2003	Tu-Chen Cheng	DAM 588-02	3844

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US ARMY SOLDIER AND BIOLOGICAL CHEMICAL COMMAND
OFFICE OF THE CHIEF COUNSEL/IP TEAM (BLDG E4435)
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APG, MD 21010-5424

EXAMINER

WARE, DEBORAH K

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,206

Applicant(s)

CHENG ET AL.

Examiner

Deborah K. Ware

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-34 are pending.

Election/Restrictions

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to a decontaminant composition , classified in class 424, subclass 94.1.
- II. Claims 29-34, drawn to method of making decontaminant, classified in class 435, subclass 262.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as by making a foaming agent without the need of water as required by the method claims of Group II.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Biffoni on March 7, 2006, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elashvili (US 6897032) in view of Favre-Bulle et al (US 5616498), Akkara et al (US 5169554), and Pillar et al (US 6922615), all cited on enclosed PTO-892 Form.

Claims are drawn to a decontaminant composition comprising OPH, OPAA, DFPase, dehalogenase, ammonium salts and pH control agent. Fire agents are also incorporated into the composition.

Elashvili teaches OPH and OPAA enzymes capable of decontaminating chemical warfare agents, see col. 3, line 8.

Favre-Bulle et al teach dehalogenase is capable of decontaminating impurities in surfactants, note col. 1, lines 54-56. Further, they teach ammonium salts to be present during the production of their decontaminant, see column 4, line 30.

Akkara et al teach that DFPase has detoxifying activity, note col. 11, lines 67-68 and col. 12, lines 7-10. Also a buffer system is disclosed which functions to control pH.

Pillar et al teach fire fighting agents, such as water, foam, foaming agents, etc., note col. 25, lines 28-30.

The claims differ from Elashvili in that not all of the enzymes and other decontaminant ingredients are disclosed.

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It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the cited prior references of Elashvili, Akkara, Favre-Bulle and Pillar, all cited above to provide for a decontaminant composition having all of these well known properties and decontaminating activities as taught by the cited prior art. These enzymes and other compounds (i.e. ammonium salt, and fire fighting agents) are combinable in the art for the same purpose. One of ordinary skill in the art would have expected successful results. To select for microbial sources of useful enzymes is well within the purview of a skilled artisan.

To vary and optimize amounts, therefore, for purposes of decontamination is clearly within the skill of a practitioner. Detergents are clearly disclosed by the cited prior art to be present in the prior art decontaminant composition. Trademarked fire agents and detergents are merely an obvious modification of the cited prior art and one of skill would have been motivated to provide these agents to provide for non-flammable compositions and to guard against potential danger of combustible reactions with the chemicals employed to treat a site and those reactions which can occur at a site in need of treatment. In the absence of persuasive evidence to the contrary the claims are deemed *prima facie* obvious over the cited prior art.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

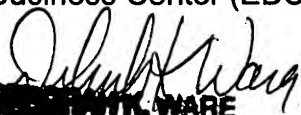
No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware
March 18, 2006